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KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			JARRETT, SCOTT L	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HC

Office Action Summary

Application No.

09/803,329

Applicant(s)

STAVRULOV, IGOR
ANATOLIEVICH

Examiner

Scott L. Jarrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This **Final** Office Action is responsive to Applicant's amendments filed May 27, 2005, May 31, 2005 and July 5, 2005. Applicant's amendments amended the specification, amended claims 1-11, 13-18, added new claim 21 and canceled claims 12 and 19-20. Currently claims 1-11, 13-18 and 21 are pending.

Response to Amendment

2. Applicant's amendments filed May 27, 2005, May 31, 2005 and July 5, 2005 necessitated the new ground(s) of rejection.

Response to Arguments

3. Applicant's arguments with respect to claims 1-11, 13-18 and 21 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that the applicant did not challenge the Official Notice(s) cited in the First Office Action therefore those statements as presented are herein after prior art. Specifically it has been established that it was old and well known in the art at the time of the invention:

- to place (print, label, etc.) a plurality of information (text, designs, instructions, information, symbolics, indicia, etc.) on products thereby enabling businesses to distinguish (customize, individualize, etc.) their products, via its packaging, through the use of unique advertising, marketing and branding executions;

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- that games, such as the cookie game as taught by Mueller, lose their entertainment value and or their ability to maintain consumer interests without the ability to vary the game's content (written information); would have been uninteresting and useless without the ability to vary the written information between cookie games, in essence making each cookie game identical;

- that effective frequency is commonly used in marketing/advertising to determine the optimal (best, ideal, etc.) frequency (number of times) an advertisement (message, image, text, etc.) is to be seen by a consumer in order to elicit a desired consumer response (e.g. product purchase/use) wherein the effective frequency level for a particular message (campaign) is determined by analyzing a number of factors including but not limited to a brand's purchase and usage cycle, brand share, competitive activity, consumer attitudes towards the brand, creative impact and the medium to be used; and

- that products/packages are commonly assembled/packaged of into cartons (boxes, containers, etc.) for distribution (shipping, transporting, etc.) purposes.

Claim Objections

4. Claims 12 and 16 are objected to because of the following informalities.

Regarding Claim 12, Claim 12 is incorrectly labeled as "previous presented" when in fact the claim is canceled.

Appropriate correction is required.

Regarding Claim 16, Claim 16 contains a grammatical error "first".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1-11, 13-17 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding Claims 1, 4-7 and 14-15, Claims 1, 4-7 and 14-15 recite the limitation that each package (consumer, individual, carton, etc.) is assembled (filled, created,

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built, etc.) by placing **randomly** selected/assembled images/packages onto/into the package in such a way that the package “....will **appear** to bear a **different** image at each consumer’s purchase” (emphasis added).

Examiner finds the claims contradictory and confusing in light of the applicant’s disclosure, the prior art and knowledge possessed by one skilled in the art that time of the invention; specifically how does randomly selecting/assembling images/packages *guarantee* the results as claimed (i.e. that consumers will *appear* to see different images).

As per applicant’s own admission known methods exist for “providing the consumer with varying images on the individual package” (Specification: Lines 9-10, Page 9; Lines 9-19) wherein the known methods “appear” to randomly distribute images on packages (products, goods, etc.; Specification: Line 13, Page 4; Line 20, Page 2) . The disclosure further teaches that the known methods for randomly selecting/assembling images/packages do not “result in the consumer being likely to see a different image on each product purchased or used” (Specification: Lines 10-11, Page 4).

Further the disclosure suggests that the instant application provides a better/improved method for varying images on packages with varied and non-repeating images on packages over a period of time (i.e. suggests a method for preparing a group of customized packages other than the disclosed well known random selection methods as now claimed; Specification: Lines 27-30, Page 4).

7. Claims 1, 4-7 and 14-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure fails to state or teach one of ordinary skill in the art how to select a size of a group of images/packages in such as to *ensure* that the packages "....will **appear** to bear a **different** image at each consumer's purchase" (emphasis added) as claimed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 13 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 13, Claim 13 recites the limitation "one group of **consumer** packages at a time" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 16, Claim 16 recites the limitation "the **first** group of images" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

Examiner interpreted claim to read "the ~~first~~ group of images" for the purposes of examination.

Regarding Claim 17, Claim 17 recites the limitation "the **second** group of images" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

Examiner interpreted claim to read "the ~~second~~ group of images" for the purposes of examination.

Claim Rejections - 35 USC § 101

10. Claims 1-11, 13-18 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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Regarding Claims 1-11, 13-18 and 21, claims 1-11, 13-18 and 21 only recite an abstract idea. The recited method for preparing customized product packaging does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The claimed invention, as a whole, is not within the technological art as explained above claims 1-11, 13-18 and 21 are deemed to be directed to non-statutory subject matter.

Examiner suggests that the applicant incorporate into Claims 1-11, 13-18 and 21 language that the proposed method is a computer-implemented (computerized) method and that at least one of the method steps are implemented by a computer and show support for the proposed amendments to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1-11, 13-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller, Irene Elma, U.S. Patent No. 3,770,278 in view of Brochhausen, James M., U.S. Patent No. 6,206,190.

Regarding Claims 1 and 18 Mueller teaches a method for preparing a customized product package (cookie game) by varying images (text, symbology, indicia, graphics, etc.) in the packages (products, cookies, goods, items, components, etc.):

- selecting a size of a group of packages (products, cartons, wrappers, labels, items, components, cookie fortune strips, etc.) that a consumer will purchase (play, use) without the consumer seeing the same image (written information, indicia, graphic, symbology, text, picture, etc.) repeated (a predetermined plurality of fortune cookies each cookie having a strip of paper upon which different information is contained; Claims 1, 3, 4 and 5; Figure 1; as per applicants own admission an image includes pictures, text, and the like; Specification, Page 9, Lines 8-14);

- determining a size of a group of different images (text, written information) as a function of the size of a group of packages (the size of the group of written information being equal to the number of fortune cookies in the cookie game; Figures 1 and 5);

- selecting different images (written information) equal in number to the size of the size of the group of different images (Figures 3 and 5; Abstract; Column 1, Lines 25-27; Column 2, Lines 8-22; Column 3, Lines 5-10; Claims 4-6); and

- preparing (manufacturing, creating, developing, etc.) a group of packages (cookies) by placing (printing, sticking, applying, forming, labeling, etc.) one image (written information) selected from the group of different images (segment, written information) in one package (cookie) and continuing to insert/place one image (written information) from the set (segment of the written information) per package (cookie) until all the packages (cookies) are completed/prepared (i.e. continuing until every written information segment has been placed into a fortune cookie, such that each group of different written information segments appears at least once in a fortune cookie and no fortune cookie contains more than one written information segments from the group of different written information; Column 2, Lines 40-45; Figures 1-5; Claims 1 and 5);

- randomly placing the prepared packages from the group of packages into a package (consumer, carton, game box, etc.; "The cookies are place in a package at random.", Lines 20-21, Column 2);

- thereby ensuring that the images (written descriptions) contained in each of the packages (cookies) in the group of packages (cookie game) appear to the customer to be different (i.e. there is a very low probability of repeating images as each of the fortune cookies in the cookie game are distinct segments of the written information) and further wherein the information segments are interrelated and packaged as a set such

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that once the game is played (purchased and used) the information segments combine to form a new/complete written composition (Abstract; Figures 4 and 5; Column 2, Lines 15-17; Column 1, Lines 21-41).

Mueller further teaches that it is well known in the art that fortune cookies are randomly selected/packaged and are manufactured in sufficiently large numbers of different types of fortunes so that the chances of a consumer seeing a duplicate fortune is minimized (i.e. it will appear to the customer that the packages contain different images each time the package is purchase and/or used; Column 2, Lines 1-8).

Mueller is silent on how the images (written information) is selected from the group of images (segment) and does not teach that the images (written information) are placed on the packages (cookies) as claimed.

Brochhausen teaches randomly selecting/placing one or more distinctive images (collectible cards, individual package; Figure 4, Element 100; Column 3, Lines 29-32 and 49-65) into a consumer package (consumer package, can, container, etc.), in an analogous art of assembling entertainment packages (games, collectibles, etc.; Figure 4, Element 114), "such that an undetermined number of packages may be collected before a particular card and associated distinctive image are collected" (Column 1, Lines 65-66; Column 2, Lines 45-62; i.e. it will appear to the customer that the packages will contain different images each time the package is purchase and/or used).

More generally Brochhausen teaches a method for preparing (assembling; Figure 4) customized product packaging by varying images on packages of products (cards, cans, etc.; Figures 1-3) wherein users collect (purchase, use) the custom (distinctive) packages over a period of time because the manufacturer (business) varies the packages making them interesting as well as visually appealing (Column 1, Lines 10-25).

It would have been obvious to one skilled in the art at the time of the invention that the method for preparing customized product packaging by varying images (written information, segments) appearing in packages of products (cookies, cookie game) would have benefited from randomly selecting and placing distinctive images both inside and outside the packages (cards, cans, cookie fortune strips, cookies, cookie game carton/package, etc.) in view of the teachings of Brochhausen; the resultant method varying the images/packages in such a way as to entice consumers to purchase (collect, use, play, etc.) the packages/products over a period of time by making the packages increasingly interesting and visually pleasing (Brochhausen: Column 1, Lines 21-23).

Regarding Claims 2 and 10 Mueller teaches that the method for preparing customized packaging by varying images in packages of products further comprises preparing (filling, completing, creating, assembling, etc.) more than one group of

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packages (individual, consumer, cookies, games, cookie fortune strips, etc.) at a time (Column 2, Lines 39-46).

Regarding Claims 3, 11 and 16-17 Mueller teaches that the method for preparing customized packages by varying the images on/in the packages (strips, cookies, etc.) utilizes variety of sources to obtain a variety of images (written information) to be placed onto the fortune cookie slips (packages) and into the fortune cookies (packages; Column 3, Lines 5-10).

Mueller does not expressly teach changing the images in the group of different images (updated, rotated, etc.) after a *selected period of time* as claimed.

Official notice is taken that, as cited in the first office action, varying the content (images, written information, etc.) in entertainment products (venues, packages, etc.) over select periods of time wherein a variety of images are used to entice consumers to purchase/use the product (package, game).

For example a game without the ability to vary the games content (images, written information) between games (purchase, use) essentially makes each game making each game identical wherein the products have little to no entertainment value. Therefore without the ability to vary the games content (written information, images, etc.) a consumer purchasing (using) more than one game (product, cookie game) would

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have discovered the exact same game (written information) thereby relieving the game of any of its entertainment value or its ability to maintain consumer interest.

It would have been obvious to one skilled in the art at the time of the invention that the method for preparing customized packages as taught by Mueller with its utilization of a plurality of sources for images (written information) would have inherently included a means for varying the written information contained in a plurality of packages (cookies, cookie games, etc.) over a selected period of time; the resultant method becoming increasingly varied and interesting to consumers.

Regarding Claims 4-5 Mueller teaches a method for customizing product packaging by varying images appearing on/in packages of products (items, cookies, etc.) further comprising:

- producing a group of individual packages (fortune cookie strips, fortune cookies; Abstract);
- assembling a consumer package by placing (filling, putting, etc.) at least two/three packages (1 dozen cookies, products, items, containers, orders, boxes, cartons, etc.) from the group of individual packages into the consumer package (fortune cookie, fortune cookie game; i.e. assembling a plurality of the fortune cookies into a cookie game box; Figure 1, Element 10; Column 2, Lines 38-46); and

- randomly (random visual order) placing (filling, putting, etc.) at least three packages (fortune cookies) from the group of individual packages into the consumer package (cookie game; Column 2, Lines 20-21);

- whereby each individual package (cookie, fortune strip) in the consumer package (cookie, cookie game) will appear to the consumer to bear (contain, comprise, display, etc.) different images (written descriptions; i.e. there is a very low probability of repeating images as each of the fortune cookies in the cookie game are distinct segments of the written information) and further wherein the information segments are interrelated and packaged as a set such that once the game is played (purchased and used) the information segments combine to form a new/complete written composition (Abstract; Figures 4 and 5; Column 2, Lines 15-17; Column 1, Lines 21-41).

Regarding Claims 6-7 and 14-15 Mueller teaches a method for preparing customized product packages wherein the method further comprises producing a group of consumer packages (e.g. producing a plurality of fortune cookie games that can be used/purchased/played by a number of guests/groups; Column 2, Lines 63-68; Column 3, Lines 1-10) whereby each individual package (cookie) in the consumer package will appear to the consumer to bear (contain, comprise, display, etc.) different images as discussed above.

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Mueller does not expressly teach the assembly/production of a carton (box, container, etc.) containing at least two/three randomly placed (filled, generated, packed) consumer packages as claimed.

Official notice is taken that, as cited in the first office action, assembling/packaging a plurality of packages (individual packages, products, items, etc.) into containers (boxes, cartons, pallets, etc.) for distribution is old and very well known in the art as evidenced by at least the applicant's own admission (Specification, Page 2, Lines 5-9; Page 3, Lines 1-20).

Further official notice is taken that packages (cartons, containers, etc.) are typically/commonly packaged/assembled in an ad hoc and/or random fashion (random order, random visual order, not in a planned order).

It would have been obvious to one skilled in the art at the time of the invention that the method for preparing customized packages as taught by Mueller would have benefited from using any of the plurality of well known systems/methods for assembling products into cartons (boxes, consumer packages, etc.) wherein these systems commonly (by default) randomly (ad hoc, unplanned) pack/assemble packages; the resultant method providing a convenient means for distributing the prepared consumer packages.

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Regarding Claims 8-9 and 21 Mueller does not expressly teach that determining the size of the group of packages (cookies) will see without repetition by selecting a period of time for which non-repetition is desired (i.e. not see the same image repeated) or subsequently determining a typical number of packages purchase/used by the consumer over the selected period of time as claimed.

Official notice is taken that effective frequency, as cited in the first office action, provides a well known method for determining (selecting) the number of times in a given time period a message (advertisement, text, images, etc.) should be seen by a customer in order to elicit a desired consumer response (e.g. purchase, use, etc.) wherein the effective frequency is a function of the consumer purchase/use cycles, brand share, competitive activity, consumer attitudes towards the brand, creative impact and the medium to be used.

Further the effective frequency is a balance between having a consumer not see/view of message enough (under exposed) and the message becoming repetitive (over exposed).

It would have been obvious to one skilled in the art at the time of the invention that the method for preparing custom packages as taught by Mueller would have benefited from employing the old and well known effective frequency and/or other marketing/advertising techniques to determining the size of the group of packages (consumer packages, fortune cookies, cookie games, etc.) necessary to insure that it

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would appear to the consumer that the packages are different (written information and/or games are not identical) during a selected period in view of the teachings of official notice; the resultant method ensuring the packages (cookie games) ability to maintain its entertainment value by not repeating the game's content within the user's purchase/use cycle.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Kuske et al., U.S. Patent No. 6,318,555, teach a method for packaging products having different/varying images/graphics to provide visual cues/enticements for consumers to purchase the packages of products.

- Heggerty, Eugene, U.S. Patent No. 6,533,274, teaches a method for preparing customized packages by varying images appearing on the packages of products wherein images (numbers, symbols, etc.) are randomly selected and placed on packages (game cards) for the promotional purposes.

- Focke et al., EP 905027 A1, teaches a method and system for manufacturing cigarette packages wherein the packages have individual messages (images, logos, indicia) printed on them.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571) 272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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SJ

9/28/2005



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